

REMARKS

In the Office Action,¹ the Examiner objects to the specification as failing to provide antecedent basis for claims 21, 32, and 48; rejected claims 1, 3-6, 9-11, 13-15, 18-21, 23, 25, 31, 32, 34, 36-38, 40, 41, 43, 44, and 46-48 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 7,111,042 to Kikugawa ("Kikugawa") in view of U.S. Patent No. 6,011,895 to Abecassis ("Abecassis"), and further in view of U.S. Patent 6,983,483 to Maze et al. ("Maze"); rejected claims 2, 12, 24, 35, and 42 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa, Abecassis, and Maze, and further in view of U.S. Patent No. 6,424,997 to Buskirk, Jr. et al. ("Buskirk"); and rejected claims 26-29 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa, Abecassis, and U.S. Patent No. 7,107,271 to Aoki et al. ("Aoki"), and further in view of Maze.

Applicant respectfully traverses the objection to the specification. The Office Action objects to the specification because "while the specification does illustrate ROM, RAM, and other such terms, it does not limit the claimed subject matter to these specific embodiments. It is necessary to limited the embodiments to a subset . . . so that non-statutory subject matter is not included." Page 21.

The Office Action, however, does not point to any parts of the specification that would allow the claimed "computer-readable storage medium" to be construed to constitute non-statutory subject matter. To the contrary, the specification only discloses the claimed computer-readable storage medium as being tangibly embodied. For example, paragraph 153 states, "a recording medium such as a magnetic disk 62, an

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

optical disk 63, a magneto-optical disk 64, or a semiconductor memory 65” (emphasis added). Similarly, paragraph 386 states, “[t]he recording medium storing software programs . . . may be a package medium based on magnetic disk (including flexible disk) 62, 150, optical disk (including CD-ROM (Compact Disk Read-Only Memory) and DVD (Digital Versatile Disk)) 63, 151, magneto-optical disk (including MD (Mini-Disk)) 64, 152, or semiconductor memory 65, 153 . . . ” (emphasis added).

Accordingly, the claimed computer-readable medium cannot be properly construed as constituting non-statutory subject matter (e.g., a carrier wave or a signal), as the specification only discloses the medium as having a physical embodiment. Moreover, Applicant submits that a claim scope issue should be addressed by way of a claim objection or rejection, not an objection to the specification for antecedent basis. The Office Action seems to confuse an antecedent basis issue in the claims with a patentable subject matter issue. Therefore, the objection to the specification is improper, and Applicant respectfully requests its withdrawal.

Applicant respectfully traverses the rejection of claims 1, 3-6, 9-11, 13-15, 18-21, 23, 25, 31, 32, 34, 36-38, 40, 41, 43, 44, and 46-48 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa in view of Abecassis, and further in view of Maze.

As an initial matter, Applicant notes that “the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original). MPEP § 2141.02(I). Thus, it is improper to “dissect a claimed invention into discrete elements and then evaluate the elements in isolation” (emphasis added). MPEP § 2106(II)(C). Applicant respectfully submits that the Office Action fails to consider the claims as a

whole and, instead, improperly dissects the claims and analyzes the claimed elements in isolation.

For example, at page 5 the Office Action states, “Kikugawa does not explicitly indicate ‘program’ or ‘for obtaining information about a program’ Abecassis discloses ‘program’ . . . and ‘for obtaining information about a program’” Similarly, at page 5 the Office Action states, “[n]either Kikugawa nor Abecassis explicitly indicate ‘television.’ However, Maze discloses ‘television’” Claim 1, however, does not recite merely “program” and “television.” Claim 1 recites “searching . . . for television program information associated with [an interest word extracted from an electronic mail message associated with the user],” and “sending the television program information identified by the search to the information processing apparatus.” Thus, instead of analyzing the claims as a whole, the Office Action improperly extracts the claimed elements from their proper context in the claims and then examines the elements in isolation.

For the following reasons, Kikugawa, Abecassis, and Maze, taken alone or in combination, fail to disclose or suggest a combination comprising at least “means for searching . . . for television program information associated with [an interest word extracted from an electronic mail message associated with the user]”, and “means for sending the television program information identified by the search to the information processing apparatus.”

Kikugawa discloses, “an electronic bulletin board system, which communicates with a user computer via a network, and mediates information exchange therebetween by an electronic bulletin board function.” Abstract. Specifically, in Kukugawa, “when an

e-mail . . . is sent from a user computer, the mail server refers the e-mail text to the notable words collection. When the referred e-mail text has a notable word . . . an appropriate URL for the notable word is set as a link destination. And the mail server sends the e-mail, to which the link destination is set, to the Internet directing to the e-mail address of the recipient.” Col. 8, ll. 16-24.

Thus, Kikugawa discloses a system that inserts in to e-mails posted or bulletin board messages links to URLs associated with certain words found in the e-mails or bulletin board messages. Kikugawa, however, does not “search[] . . . for television program information associated with [an interest word extracted from an electronic mail message associated with the user],” and “send[] the television program information identified by the search to the information processing apparatus,” as recited by claim 1. Indeed, Kikugawa, is completely unconcerned with searching television program information.

Abecassis fails to remedy the above-noted deficiencies of Kikugawa. In Abecassis, “each segment [of a program] is analyzed as to subject matter and assigned the necessary keyword . . . [which] provides the capability for inhibiting the viewing of undesirable subject matter” Col. 7, ll. 8-11 and 16-18. Programs are then played on a segment-by-segment basis in accordance with a user’s preferences. Col. 9, ll. 53-64; and col. 13, ll. 13-21.

Thus, Abecassis discloses a custom programming censorship system “permitting the viewer to decide for themselves the level of censorship that they may desire.” Col. 8, ll. 25-26. Abecassis, however, does not disclose or suggest “searching . . . for television program information associated with [an interest word extracted from an

electronic mail message associated with the user],” and “sending the television program information identified by the search to the information processing apparatus,” as recited by claim 1.

Maze fails to remedy the above-noted deficiencies of Kikugawa and Abecassis. Maze discloses an “apparatus . . . for searching the [television program] listing for specific user-entered information, and upon successful conclusion to the search, the apparatus schedules the tuning of the desired program, or in the alternative, notifies the viewer of the availability of the program” (emphasis added). Abstract. That is, Maze discloses a system that allows a user to manually search television program listings by entering search terms. See, col. 2, l. 33 - col. 3, l. 25. Maze, however, fails to disclose or suggest “searching . . . for television program information associated with [an interest word extracted from an electronic mail message associated with the user]”, and “sending the television program information identified by the search to the information processing apparatus,” as recited by claim 1.

Accordingly, even if the prior art is combined as proposed in the Office Action, there is no teaching or suggestion of “searching . . . for television program information associated with [an interest word extracted from an electronic mail message associated with the user],” and “sending the television program information identified by the search to the information processing apparatus,” as recited by claim 1. That is, even if Kikugawa’s system for inserting a link for a notable word in a bulletin board message, Abecassis’ television program censoring system, and Maze’s manually searchable program guide were combined, it would not have been obvious to “search[] . . . for television program information associated with [an interest word extracted from an

electronic mail message associated with the user],” and to “send[] the television program information identified by the search to the information processing apparatus,” as recited by claim 1. Thus, the prior art fails to render obvious the subject matter of claim 1, when the claim is taken as a whole.

Notwithstanding the above-noted deficiencies of the prior art, the rejection under § 103 is improper because the cited references are directed to nonanalogous prior art. See MPEP § 2141.01(a). As set forth above, Kikugawa is directed to a system for automatically inserting into an e-mail or an electronic bulletin board posting a link providing information about special keywords contained in the e-mail or posting. In contrast, Abecassis discloses a system that custom-censors television programming in accordance with a user’s profile. One of ordinary skill in the art would not have found it obvious to look to such disparate technologies in arriving at the subject matter of claim 1. That is, one of ordinary skill in the art would not have looked to Abecassis’ programming censorship system in trying to modify or improve Kikugawa’s bulletin board system.

Moreover, there would be no motivation to modify the prior art proposed by the Office Action. See MPEP § 2143. In considering Kikugawa, one of ordinary skill in the art would be focused on inserting informational links to URLs into e-mails or bulletin board postings, and would have no need for Abecassis’ unrelated programming censorship method. Further, it is unclear how Abecassis’s censorship method could even be incorporated into Kikugawa in some meaningful way. The Office Action alleges that the modification “giv[e] the user the advantage of more choices for view program selection.” Page 5. As set forth above, however, Kikugawa is completely unconcerned

with television programming. Thus, one of ordinary skill in the art would not have been motivated to incorporate Abecassis' program censorship method into Kikugawa's bulletin board system. Applicant respectfully submits that the Examiner's conclusion of obviousness is improperly based on knowledge gleaned only from Applicant's disclosure, rather than on the actual teachings of the prior art. See MPEP § 2145(X)(A).

For the above reasons, independent claim 1, when considered as a whole, is clearly allowable over Kikugawa, Abecassis, and Maze. Independent claims 11, 21, 23, 31, 32, 34, 41, 47, and 48, though of different scope than claim 1, are allowable over Kikugawa, Abecassis, and Maze for at least similar reasons as claim 1. Claims 3-6, 9, 10, 13-15, 18, 19, 25, 36-38, 40, 43, 44, and 46 are allowable at least because of their dependence from the independent claims.

Applicant respectfully traverses the rejection of dependent claims 2, 13, 24, 35, and 42 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa, Abecassis, and Maze, and further in view of Buskirk.

Dependent claims 2, 13, 24, 35, and 42 are allowable over Kikugawa, Abecassis, Maze and Buskirk inasmuch as Buskirk fails to remedy the deficiencies of Kikugawa, Abecassis, and Maze discussed above in connection with the independent claims.

Applicant respectfully traverses the rejection of dependent claims 26-29 under 35 U.S.C. § 103(a) as unpatentable over Kikugawa in view of Abecassis, and further in view of Aoki.

Dependent claims 26-29 are allowable over Kikugawa, Abecassis, Maze, and Aoki inasmuch as Aoki fails to remedy the deficiencies of Kikugawa, Abecassis, and Maze discussed above in connection with the independent claims.

In view of the foregoing, Applicant respectfully requests reconsideration of this application, withdrawal of the rejections, and the timely allowance of the pending claims. If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is kindly invited to contact the undersigned at 202.216.5118.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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